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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/595,766  | 05/10/2006  | Thomas A. Beyer      | PC25123A                      | 6301             |
| 28523   | 7590        | 10/18/2007           |                               |                  |
| PFIZER INC.<br>PATENT DEPARTMENT, MS8260-1611<br>EASTERN POINT ROAD<br>GROTON, CT 06340 |             |                      | EXAMINER<br>JAISLE, CECILIA M |                  |
|   |             |                      | ART UNIT                      | PAPER NUMBER     |
|   |             |                      | 1624                          |                  |
|   |             |                      | MAIL DATE                     | DELIVERY MODE    |
|   |             |                      | 10/18/2007                    | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                               |                              |  |
|------------------------------|-------------------------------|------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/595,766 | Applicant(s)<br>BEYER ET AL. |  |
|                              | Examiner<br>Cecilia M. Jaisle | Art Unit<br>1624             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED OFFICE ACTION

### ***Request for Disclosure of Prior Art***

If the compounds excluded by the proviso in claim 1, lines 5-6, are known in the prior art, Applicants are required to specifically identify such disclosure so that further issues of patentability may be considered. 37 CFR 1.105. MPEP 704.11.

### ***Lack of Unity***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-8, 12-14, 16-18 and 20, drawn to pyrido[2,3-d]pyrimidine compounds, classified in class 544, subclass 270, and pharmaceutical compositions comprising them and pharmaceutical methods using them, classified in class 514, subclass 264.11.
- II. Claims 9-11 and 19, drawn to pharmaceutical compositions comprising a PDE2 inhibitor, an EP2 selective receptor agonist and pharmaceutical methods of using them, variously classified in class 514.
- III. Claim 15, drawn to a method of treating bone fracture and/or defect in a mammal, variously classified in class 514.

Art Unit: 1624

Each group as set forth above lacks unity with each other group, i.e., there is no single general inventive concept. The unique special technical features in each group are the identities of the compounds that are described as PDE2 inhibitors, regardless of the structure of such compounds. The technical relationship between the inventions does not involve at least one common or corresponding special technical feature. The expression "special technical feature" is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. In this case, a reference that could be used to reject the compounds, compositions and methods of Group I could not be used to reject the compositions and methods of Group II.

The Group I invention has special technical features not common to Groups II and III and would be expected to be useful other than as disclosed, e.g., as agricultural insecticides (US 5547954 and US 5710157; cited by Applicants).

It was not possible to present this Lack of Unity requirement by telephone, because the file contained no telephone number to contact the attorney of record, Mr. Lyman Smith. An attempt was made to contact Mr. Smith at the telephone number on the Roster of Agents and Attorneys, but there was no answer. Applicant is requested in replying to this Lack of Unity requirement to provide a telephone number at which Applicant's attorney of record can be reached.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above

Art Unit: 1624

and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that a complete reply to this requirement must include**

**(i) election of an invention to be examined** though the requirement be traversed (37 CFR 1.143) **and (ii) identification of claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, election shall be treated as an election without traverse. Traversal must be presented at the time of election to be considered timely. Failure to timely traverse the requirement will result in

Art Unit: 1624

the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product claims (Groups I and II) and method claims (Groups III and IV). Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn method claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected method invention must require all the limitations of an allowable product claim for that method invention to be rejoined.

Art Unit: 1624

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined claims will be withdrawn, and the rejoined claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and method claims may be maintained. Withdrawn claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, **applicant is advised that the method claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the examiner withdraws the restriction requirement before the patent issues. See MPEP § 804.01.

### ***Conclusion***

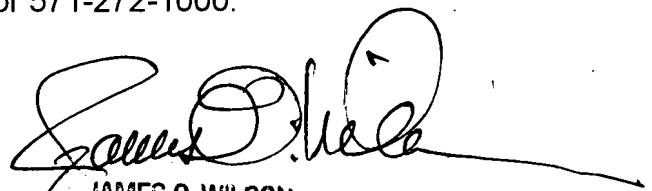
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cecilia M. Jaisle, J.D. whose telephone number is 571-272-9931. The examiner can normally be reached on Monday through Friday; 8:30 am through 5:00 pm.

Art Unit: 1624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cecilia M. Jaisle, J.D.  
10/12/2007



JAMES O. WILSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600